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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,061	07/09/2003	Alexander Craig MacKay	MRKS/0092	9534

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EXAMINER

DANG, HOANG C

ART UNIT PAPER NUMBER

3672

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HL

Office Action Summary

Application No.

10/616,061

Applicant(s)

MACKAY ET AL.

Examiner

Hoang Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-20 is/are allowed.
- 6) ☒ Claim(s) 1-13, 21-51 and 53-63 is/are rejected.
- 7) ☒ Claim(s) 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/03/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the species of Figures 4-5 in the reply filed on July 14, 2005 is acknowledged.

Claim Objections

2. Claims 8, 23, 24, 29, 54-57 and 61 are objected to because of the following informalities:

As for claim 8, it should depend on claim 7 since the "fourth diameter" is not introduced until claim 7". Similarly, the term "a third diameter" in claims 23-24 has no proper antecedent basis since the "second diameter" is not introduced until claim 22. The same is applied to the term "a fourth diameter" in claim 29.

As for claims 54-57 and 61, the term "the tubing" in claims 54-57 and 61 has no proper antecedent basis. Base claim 1 recites "first tubing length" and "second tubing length".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 59 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to clearly disclose and show how a fixed diameter expansion tool can expand the first and second tubing lengths of the species of Figures 4-5 as recited in claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-11, 21-25, 27, 29-32, 35-37, 41, 42, 44, 46-48, 54, 57, 58 and 60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by the Russian document (RU 20064357).

The claimed method steps read exactly on the RU '357 reference when an upper shaped pipe of the shaped-pipe blocking device 21 is considered as the "first tubing length" and an lower shaped pipe of the shaped-pipe blocking device 21 is considered as the "second tubing length" as recited. It is noted that the RU '357 reference discloses that the threaded joints (overlapped portions) of the shaped pipes of the blocking device 21 are also expanded to the shaped piped inner diameter (see last 5 lines of the 9th paragraph under "Description" of the translation). Therefore, the upper overlapped end of the lower shaped-pipe of the RU '357 reference is expanded to a "second diameter" and the lower end of the lower shaped-pipe is expanded to a third diameter as recited (see figure 1).

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As for claims 7-8 and 29, since the claims do not preclude the “second diameter”, “third diameter”, “fourth diameter” and “fifth diameter” be equal, the claims do not distinguish from the RU reference.

As for claims 10, 11, 31 and 32, since these claims do not require that the “first tubing length” is expanded, the “first tubing length” does not distinguish from casing 20 of the RU ‘357 reference.

7. Claims 1-3, 5-13, 21-25, 27-38, 41-45, 47-51, 53, 54, 58 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by the Russian document (RU 2079633).

The claimed method steps read exactly on the RU ‘633 reference when casing 1 and shaped pipe 8 are respectively considered as “first tubing length” and “second tubing length” as recited. Alternatively, the claimed method steps also read exactly on the RU ‘633 reference when upper shaped pipe 8 and lower shaped pipe 12 are respectively considered as “first tubing length” and “second tubing length” as recited.

As for claims 7-8 and 29, since the claims do not preclude the “second diameter”, “third diameter”, “fourth diameter” and “fifth diameter” be equal, the claims do not distinguish from the RU reference.

As for claim 51, the inner diameter of portion 9 constitute the “second diameter” and the inner diameter at the upper, overlapped end of member 12 constitutes the “third diameter”

8. Claims 36, 37, 39-42, 44, 47 and 48 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smith (US 6,808,022) (see tubing 12 in figure 2).

9. Claims 1-4, 9-13, 21, 23-26, 30-39, 40, 44, 47, 48, 54, 57, 59, 60, 61, 62 and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by Baugh et al (US 6,598,677).

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The claimed structure reads exactly on the reference's structure when members (12, 36, 98 or 112) and (10, 28, 92 or 110) of Baugh et al are respectively considered as "first tubing length" and "second tubing length" as recited.

With respect to the first embodiment of Baugh et al (i.e., casing 12 and tubular 10), the expanded portion of tubular 10 above opening 20 constitutes the first portion of the second tubing length as claimed. The expanded portion of tubular 10 immediately below opening 20 constitutes the second portion of the second tubing length as recited. It is noted that some claims including claim 1 do not require that the second diameter be different from the third diameter.

With respect to the remaining embodiments of Baugh et al (i.e., casing 36, 98 or 112 and tubular 28, 92 or 110), the four flat sides shown in figures 8, 22 and 28 constitute the "first portion" of the second tubing length and the four round corners shown in same figures constitute the "second portions" of the second tubing length as recited.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 39-43, 46, 55-60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Russian document (RU 20064357) or the Russian document (RU 2079633).

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As for claims 55-56, as pointed out above, base claim 1 from which claims 55-56 depend does not require that the "first tubing" be expanded. The "first tubing" therefore does not distinguish from casing 20 of the RU '357 reference. The RU reference does not show the lower end of casing 20. However, the examiner takes Official notice that it is well known in the art to provide the lower end of the production casing with slots, perforations or well screen including expandable screen to allow formation fluids to flow into the wellbore so that it can be produced to the surface through production tubing.

As for claims 39-43, 46, 57-60 and 62, the examiner takes the Official notice that the various types of expanders recited in these claims are well known and used or selected to expand downhole tubular members based on the nature of the individual well and/or job. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the various types of expander as claimed for the above reason.

Allowable Subject Matter

12. Claims 14-20 are allowed.
13. Claim 52 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

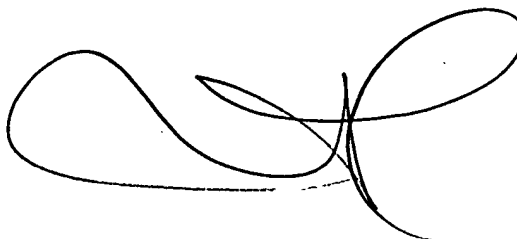
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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 571-272-7028. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang
Primary Examiner
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A handwritten signature in black ink, consisting of a large, stylized loop followed by a series of overlapping strokes that form a complex, cursive shape.